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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,189	07/24/2001	Steven N. Terranova	2400-171A	8221
27820	7590	11/05/2003	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C.			BANGACHON, WILLIAM L	
P.O. BOX 1287			ART UNIT	
CARY, NC 27512			PAPER NUMBER	

2635

DATE MAILED: 11/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/912,189

Applicant(s)

TERRANOVA, STEVEN N.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-10, 13-28 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13-28 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 1 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Examiner's Response***

1. In response to the application filed 24 July 2001, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-3, 6-10, 13-28, and 34-36 are unpatentable for the reasons set forth in this Office action:

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 08 April 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of USP 6,098,879 and 6,422,464 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Objections***

3. Objections to the claims in the last Office action are withdrawn.

4. (New) Claims 1 and 34 are objected to because of the following informalities:

Claim 1 recites the numbering e) to f) and claim 34 recites the numbering c) to d).

These were not underlined as being amended. Claim 1 should recited the numbering a) to d) and claim 34 should recited the numbering a) to c).

Appropriate correction is required.

***Double Patenting***

5. The double patenting rejection in the last Office action is withdrawn.

***Priority***

6. Applicant is requested to update the status of the parent application cited in the first sentence of the specification.

***Response to Arguments***

7. Applicant's arguments filed 08 April 2003 have been fully considered but they are not persuasive.

Applicant argues that Randelman does not disclose "controlling a transaction at the transaction interface according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit" (page 7, last paragraph, page 8, 2<sup>nd</sup> paragraph). The examiner respectfully traverses applicant's arguments. Validating and/or invalidating a transaction (analogous to "controlling a transaction") based on customer preferences (analogous to "according to predefined parameters defining a limitation or guideline for the transaction") {col. 4, lines 40-55} stored in the card (analogous to "associated with the remote communication unit") {col. 6, lines 3-6} and sent to the transaction interface {col. 4, lines 23-25; col. 7, lines 21-32} is analogous to the claimed "controlling a transaction at the transaction interface

according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit". Therefore, the rejection to claims 1-3, 6-10, 13-28, and 34-36 is maintained in this Office action.

Further, these claim limitations are conventional on most gas stations wherein a display with keypad are used to confirm transactions (analogous to "controlling a transaction") such as whether payments are made with credit card or cash (analogous to "according to predefined parameters defining a limitation or guideline for the transaction") before proceeding with a transaction. If payment is made with a credit card, then the user swipes the card and the system is ready to pump gas if the card is valid. Obviously, these features would have been obvious in the system of Randelman because this provides a convenient and faster way to service a customer, to one of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-3, 9-10, 13-26 and 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by US 5,072,380 (Randelman et al).

Regarding claims 1-3 and 9-10, Randelman et al teaches a system for providing transaction parameters in association with a remote communication unit {see whole document} which comprises a wireless communication electronics (figures 1 and 2) adapted to receive signals including indicia/vehicle identity from remote communication units (8) {col. 2, lines 16-29}; a transaction interface to carry out transactions {col. 4, lines 19-25; col. 7, lines 21-31}; a control system and memory associated with said communication electronics and said transaction interface {col. 3, lines 13-29}; and said control system adapted to receive the indicia from a remote communication unit and control a transaction at the transaction interface involving the remote communication unit according to predefined parameters defining a limitation or guideline for the

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transaction associated with the remote communication unit {col. 1, line 26-col. 2, line 2; col. 4, lines 19-65; col. 6, lines 3-6; col. 7, lines 46-52}. Validating and/or invalidating a transaction (analogous to "controlling a transaction") based on customer preferences (analogous to "according to predefined parameters defining a limitation or guideline for the transaction") {col. 4, lines 40-55} stored in the card (analogous to "associated with the remote communication unit") {col. 6, lines 3-6} and sent to the transaction interface {col. 4, lines 23-25; col. 7, lines 21-32} is analogous to the claimed "controlling a transaction at the transaction interface according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit".

In claims 13, 14, 15, the system of claim 1 wherein said control system is connected to a network having said memory containing the predefined parameters {col. 5, lines 18-29}.

In claims 16-19, the system of claim 1 further comprising means for alerting a customer of a predefined parameter associated with said control system; wherein said control system is adapted cause said means to alert the customer when a predefined parameter is reached during a transaction; wherein said control system is adapted to cause said means to alert the customer that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the customer of an action

violating the predefined parameters {col. 4, lines 60-65; paragraph bridging cols. 5 and 6}.

In claims 20-24, the system of claim 1 further comprising means for alerting an operator of a predefined parameter associated with said control system; wherein said control system is adapted to cause said means to alert the operator when a predefined parameter is reached during a transaction; wherein said control system is adapted cause said means to alert the operator that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the operator of an action violating the predefined parameters {col. 4, lines 14-19 and lines 44-51; col. 5, lines 18-29}

In claims 25-26, said means is display {col. 7, lines 21-32}.

Claims 34-36 are directed to a method for enforcing the system of claim 1 and its independent claims and therefore rejected for the same reasons.

12. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al).

With regards to claims 6-8, although Randelman does not disclose expressly "the predefined parameters limit a transaction to a purchase amount and control a



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transaction by preventing purchase of select product”, these claim limitations would have been obvious in the system of Randelman, to one of ordinary skill in the art {col. 4, lines 19-59; col. 7, lines 32-52}. The remote communication units (8) are cross checked for credit or other billing information as soon as it is determined that the remote communication unit is a valid customer {col. 4, lines 40-42}. The remote communication units provide accounting record containing all data needed for billing, discounts, and **authorized purchases or products** {col. 5, lines 62-65}. Clearly, this implies that the control system can limit a transaction to a purchase amount (**authorized purchases**) and/or control a transaction by preventing purchase of select products (**authorized products**). Limiting a purchase or product is provided in the CPF which stores customer preferred product choices, service appointment times, accounting, or payment methods {col. 6, lines 6-8}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to “limit a transaction to a purchase amount and control a transaction by preventing purchase of select product” as claimed, in the system of Randelman, as described above, to one of ordinary skill in the art.

13. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al) in view of US 5,798,931 (Kaehler).

In claims 27-28, Randelman does not disclose said means is an audio system and speaker. These claim limitations are conventional and widely used in gas stations. Most if not all gas stations that are open 24 hours use audio system and speaker to

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communicate with their customers, especially at night, for fear of theft/hold-up wherein the doors are locked, with just the attendant inside the store. Clearly, having an audio system and speaker in the system of Randelman is beneficial in avoiding theft/holdup. An example of such a system would be the operator intercom system of Kaehler. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have an audio system and speaker in the system of Randelman because this provides deterrence to theft or holdup.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Examiner Contact Information***


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

October 29, 2003

  
BRIAN ZIMMERMAN  
PRIMARY EXAMINER